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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,284	12/27/2004	Uwe Bottcher	821-64	8916
7590 Dilworth & Barrese Suite 702 333 Earle Ovington Boulevard Uniondale, NY 11553		08/03/2007	EXAMINER HAMILTON, ISAAC N	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 08/03/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/519,284

Applicant(s)

BOTTCHEER, UWE

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06/25/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 6-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-5, in the reply filed on 06/25/07 is acknowledged. The traversal is on the ground(s) that claims 1-30 were found to possess unity of invention during international searching. This is not found persuasive because as recited in MPEP 1893.03(d) states that if the examiner finds that a national stage application lacks unity of invention, the examiner may in an Office action require the applicant in the response to elect the invention to which the claims shall be restricted. The reason that MPEP Appendix AI Annex B(c) was cited was to reiterate that unity of invention practice, not restriction, is applicable in international applications and in national stage applications. Note that if an independent claim is found to be allowable, then Appendix AI, Annex B(c) no longer applies and claims dependent therefrom will be rejoined.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fellows et al (4,709,465). Regarding claims 1, 2 and 5, Fellows discloses thin rods of glass or quartz having a diameter below 1 mm in column 3, lines 27-28; two mutually-spaced clamping locations 6 for holding a rod extended between the two clamping locations; rod cleaving blade 3 adapted to be

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brought into lateral contact with a rod at a desired cleaving point between the two clamping locations; body having piezo-electric properties 4, 511, 512, 513 carrying the blade; driving means 514 adapted to act upon the body for causing a relatively steady movement of the blade towards the desired cleaving point while subjecting the blade to a relatively small-amplitude vibratory component of movement towards and away from the cleaving point superimposed to the relatively steady movement towards the cleaving point; body 4, 511, 512, 513 is of a material varying its length through application of electric and/or magnetic fields, wherein the driving means is adapted to achieve the movements of the blade by influencing the body electrically and/or magnetically for creating length variations of the material, and that the driving means is adapted to make the body and blade vibrate with a relatively small-amplitude component having a frequency of 1kHz towards and away from the cleaving point for cleaving the rod as recited in column 3, lines 47-51.

Fellows discloses the claimed invention except for the frequency being below 1 kHz. It would have been obvious to one of ordinary skill in the art to provide a frequency below 1 kHz for the purpose of reducing the amount of power required to cleave an optical fiber. It has been held that where the general conditions of a claim are disclosed in the prior art, a limitation merely with respect to the proportion of the amplitude will not support patentability unless such limitation is critical. A small change in frequency from 1 kHz to 700 Hz is generally recognized as being within the level of ordinary skill in the art. *In re Cole*, 140 USPQ 230 (CCPA 1964). Furthermore, Applicant has not shown any criticality between having a frequency of 1000Hz (prior art) and a frequency of 999Hz (claim 1) or 750Hz (claim 2).

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Regarding claim 3, the apparatus of Fellows is adapted to cleave optical fibers as recited in the first line of the abstract.

Regarding claim 4, rods having a diameter between 50 and 200 micrometers in column 3, lines 26-29.

### *Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Suter and Wolf et al are cited for low frequencies.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IA

IH

July 30, 2007

/Kenneth E. Peterson/

Primary Examiner